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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,401	07/27/2000	Thomas A. Cocotis	36.P266	2889

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NEW YORK, NY 10112

EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/627,401

Applicant(s)
Cocotis et al.

Examiner
Cuong H. Nguyen

Art Unit
3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the amendment received on 2/20/2003, which paper has been placed of record.
2. Claims 1-46 are pending in this application.

Response to the amendment

3. Since independent claims 1, 15, 24, 38 are amended to clarify that a determination for selection is made by other than a middle man (i.e., an interactive shop/server) and a service provider. The examiner provides evident herein to show this added claimed idea is old and well-known because that decision can be made by a user. Rejections on 35 U.S.C. 103(a) are moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-9,11-14, 16-27 and 29-37, 39-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US 5,826,244) in view of Shiota et al. (US 6,324,521), and further in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115).**

Huberman substantially discloses all the limitations of the listed claims. For example, Huberman teaches a method and system for providing an open document services market over a network comprising a broker acting as an intermediary to match print suppliers with customers through a competitive bidding process. The broker collects information about document services provided by suppliers such as print shops

or publishers, receives orders for print jobs including quantity, quality, time limits and any other requirements needed to complete the job, forwards the job requirements to multiple suppliers, conducts one or more bidding rounds among interested suppliers, awards the job to the supplier or suppliers that fulfill the criteria for a winning bid, and offers the customer the opportunity to select a supplier, select from a group of suppliers, or reject all suppliers and cancel the order. The customer can then communicate order specifics to the supplier via the broker or directly and arrange payment to the supplier upon delivery of the product. The broker collects a fee from the customer, the supplier, or both. Huberman also discloses a subcontracting process whereby a print supplier can win a bid and then act as a customer by subcontracting part of the order to another supplier in a subsequent auction. Prices for recent jobs can be published by the broker to inform suppliers of current market conditions, and standard job information such as price per page for a specific quantity and type of print job can be broadcast in order to attract suppliers who typically produce the type of print service described. (see at least co. 3, line 41 - col. 4 line 23, col. 4 line 45 - col. 5 line 32, col. 8 lines 51-65, col. 13 line 54 - col. 14 line 46).

Both Huberman and Shiota et al. are silent of a user can make a selection directly to choose a service provider.

However, Tannenbaum suggests a user can select a service provider without relying on a broker, that selection is by a party different from a service provider and an interactive shop (see Tannenbaum, the advantage "The user is allowed to select lowest cost long distance telecommunication service from number of service provider"; see also Tannenbaum, the novelty); or MURATA KIKAI KK. suggests a user can select a

telephone number among stored Internet connection providers' telephone numbers, based on cost of service and degree of traffic congestion stored in fee table (see MURATA KIKAI KK , DERWENT-ACC-NO: 1999-086425, 12/04/1998 – G06F 13/00, the abstract).

It would have been obvious to one with ordinary skill in the art to implement Huberman and Shiota et al.'s idea with Tannenbaum (or MURATA KIKAI KK) suggestion because this would give a user plenty of flexibilities in selection of a service provider instead of a selection from a broker/middle-man; therefore, artisan would be appreciate that way of improving business by giving more choices to customers.

5. As per claims 3 and 26, Huberman substantially discloses the claimed invention but fails to teach transmitting digital data from an interactive shop to a service provider.

Shiota teaches transmitting digital image data, either scanned from a photograph or taken from a digital camera's memory card, over a network to a minilab or other service provider from a photo shop (see col. 1 line 62 - col. 2 line 42). It would have been obvious to transmit digital image data over a network from an interactive shop such as an over-the-counter minilab, in order to increase customer satisfaction by allowing a customer to select a remote lab or service provider best equipped to fill an order.

6. As per claims 6 and 29, Huberman substantially discloses the claimed invention but fails to teach transmitting an order status to a market portal. Shiota teaches a service provider informing a customer via electronic mail that a print order is ready to be delivered or picked up. It would have been obvious to combine Huberman's document service system with the teaching of Shiota regarding providing an order status, in order

to expedite customer retrieval of goods and therefore speedy payment for the completed order.

7. As per claim 21, Huberman substantially discloses the claimed invention but fails to teach establishing an agreement between a service provider and more than one interactive shop. Shiota teaches a network system where interactive shops such as over-the-counter laboratories (also called one-hour-photo labs) interact with a central server or broker and with wholesale labs for providing special services (see col. 7, lines 2-57). It would have been obvious to combine Huberman's document service system with the teaching of Shiota regarding between interactive shops such as minilabs, and a wholesale lab, in order to increase profits for both by allowing them to provide different printing services for customers.

8. Claims 15, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman (US 5,826,244) in view of Shiota et al. (US 6,324,521), in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115), and further in view of McGovern et al. (US Pat. 5,918,207).

The examiner submits that besides above limitations that are rejectable by above rationales, claims 15, 38 have an extra limitation of determining compatibility between a service provider and an Internet server (acting as a middle-man). Huberman, Shiota et al., Tannenbaum are silent about this feature; however, McGovern et al. suggest that feature in their invention has been made by a patron (see the summary of the invention).

It would have been obvious to one with ordinary skill in the art to implement Huberman and Shiota et al.'s and Tannenbaum (or MURATA KIKAI KK) suggestion with McGovern's idea because this would give a user plenty of flexibilities in determination before selection of a service provider instead of a selection from a broker/middle-man; therefore, artisan would be appreciate that way of improving business by giving more choices to customers.

9. Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huberman in view of Shiota, in view of Enomoto et al. (US. 5,974,401), and further in view of Tannenbaum (DERWENT-ACC-NO: 2000-072115).

Huberman and Shiota substantially disclose the claimed invention but fail to teach selecting service providers in anticipation of an order being placed, or information reflecting the level of satisfaction associated with a service provider. Enomoto teaches a digital print order system that provides a photofinisher list over the Internet for a customer to select from. The list is updated periodically and includes type of printer equipment at each photofinisher as well as a price table and a delivery date table for each. It would have been obvious to combine Huberman's document service system and Shiota's digital print system with the teaching of Enomoto regarding providing a photofinisher list over a network. Doing so would increase customer satisfaction by allowing a customer to decide which service provider has the equipment and services best suited to their needs and select that provider before placing an order over the network.

Enomoto is silent regarding associating a level of satisfaction with a service provider. However, it is well known in the business world to indicate customer satisfaction when ranking a list of merchants or suppliers, as in consumer guides, and it would have been obvious to provide this feature along with the other listed characteristics of a photofinisher list, in order to further assist customers in choosing a service provider.

Conclusion

10. Claims 1-46 are not patentable.

11. Applicant's amendment necessitated above new grounds of rejection presented in this Office action, and the amendment received on 7/18/2002 is unpersuasive. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. These cited prior art are also pertinent to claims' subject matters:

- Tannenbaum (DERWENT-ACC-NO: 2000-072115, 8/19/1999 – H04M 15/00),
Internet web site for telecommunication network for accessing telephone rate
information.
- MURATAQ KIKAI KK, (DERWENT-ACC-NO: 1999-086425, 12/04/1998 – G06F
13/00), discloses about communication terminal equipment with E-mail function –
selects one telephone number among stored internet connection providers, based
on cost of service and degree of traffic congestion stored in fee table (see the
abstract).
- K. H. Chen et al., (UK Patent App. GB 2312594 A, 10/29/1997 – H04Q 3/00),
discloses about a direct signaling telecommunication system having separate call
servers, invoking and coordinating call services provided to subscriber (see the
advantage portion).
- Agre et al., (US Pat. 6,208,857 B1 – 3/2001 – 455/428), discloses a method and
an apparatus for performing position-and-preference-based service selection in a
mobile telephone system (see Fig.5 for a subscriber selection among a preferred
service provider list).
- R. J. Dean et al., (DERWENT-ACC-NO: 2000-349479, 4/25/2000 – G06F 17/60),
Personalized electronic data services providing apparatus selects electronic data
service based on user specific data by comparing user specific data with data
describing electronic data services (see Dean et al., the novelty).
- K. Yahiro, (DERWENT-ACC-NO: 1999-397565, 8/11/1999 – H04M 11/00),
Internet telephone apparatus for calling remote location at lower rate by using
Internet network (see this article's detail description).

- Harrington, (US Pat. 5,895,454 – 4/1999 – 705/26), discloses an integrated interface for vendor/product oriented Internet websites (see the abstract).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

*Commissioner of Patents and Trademarks
Washington D.C. 20231*

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuong H. Nguyen
May 03, 2003